

REMARKS

Claim 21 has been amended to address indefiniteness problems and define the invention more precisely.

Claims 11, 12, and 21 stand rejected under 35 U.S.C. § 102(b) as anticipated by or in the alternative under 35 U.S.C. § 103(a) as being obvious over each of Kim et al., Barnes et al., Adolph et al. '397, Hostettler, Genz et al., and Okita et al. Claims 10, 11, and 21 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over Emmerling et al., in view of Hostetter et al., Okita et al., and Genz et al.

Regarding the 102(b) and initial 103(a) rejections noted above, first, applicants assume that these rejections apply to claims 10, 11, and 21 (the only claims remaining as of the last amendment in the parent case) rather than claim 12. Second, none of the above cited references discloses all of the limitations found in the present claims. None of the references discloses a formal, in the backbone of a polymer, that acts as a hydrolyzable moiety under the conditions set forth in the claim. Also, the amendment to the definition of R in claim 21 clarifies that R is only carbon, hydrogen, and oxygen atoms arranged so one chain of these atoms has only single bonds. This further defines the conditions under which the formal in the backbone acts as a hydrolyzable moiety. Therefore, the anticipation rejections noted above clearly do not apply.

Regarding the initial obviousness rejections, none of the cited references discuss, disclose or deal with the hydrolyzability issue in any manner, and, therefore, applicants argue that there would be no reason or impetus to combine or modify the references to obtain the present invention as the examiner suggests. It does not meet the burden placed upon the PTO to merely assert that similar compositions exist and minor modifications of said compositions to one skilled in the art would be obvious. Applicants assert that some knowledge that the formal in the

backbone of a polymer as described within the present claims relates to hydrolyzability would be required in order to provide an impetus to modify or combine any of the cited references. The examiner has provided no such impetus.


Regarding the inherency basis for rejection, applicants have stated time and again (in multiple office interviews regarding this application and in remarks related to previous rejections) that none of the compositions cited within the references are hydrolyzable under useful conditions (those set forth in the present claims). In the remarks to the last reply in the parent case, applicants provided a declaration from one of the present inventors, a scientist known throughout the world, with over 50 U.S. patents and over 40 years experience in the present art, indicating this fact and providing rationale as to why said compositions are not hydrolyzable. To applicants, this appears to be extremely persuasive evidence to overcome the inherency basis set forth by the examiner.

Claims 10, 11, and 21 stand rejected 35 U.S.C. § 112, second paragraph as being indefinite. Specifically, the examiner objects to the word "contains" within claim 21. Applicants have amended the claim to replace the word "contains" with "is". This further clarifies the claim. Applicants have also added language which clarifies that R is carbon and hydrogen atoms or carbon, hydrogen, and oxygen atoms and also has a single line of these atoms (normally called a chain in the art) that is single bonded. This clarifies that while the single line or backbone of R is made up of single bonded carbon, hydrogen, and possibly oxygen atoms, there might also be a double bonded oxygen atom as an "offshoot" of the line or along a separate branch from that line. This should address the potential conflict with the ester portion of the polycaprolactone claimed in claim 10 noted in the Detailed Action.

Finally, applicants note that this Detailed Action in no way addresses any of the arguments provided by applicants as part of the last reply in the parent action. Applicants humbly request that any further examination of the present invention address the above arguments and arguments provided throughout the prosecution of the parent cases in order to allow applicants to fairly prosecute this case.

Accordingly, applicant believes that claims 10, 11, and 21 are in condition for allowance and respectfully requests the examiner to withdraw all objections and rejections and allow said claims. Should the examiner need more information regarding this matter or have further suggestions regarding this application, feel free to call the undersigned at 301-744-6668.

Respectfully submitted,


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